

**REMARKS**

Claims 21-27 were pending in the instant application. This Amendment follows a personal interview held June 17, 2003 between Applicants' undersigned attorney, Patrick T. Skacel, and Examiner Clow and her supervisor, Michael Woodward. The courtesies extended Applicants' attorney during the Examiner interview are sincerely appreciated. The remarks presented in this Amendment make of record and further address the issues discussed during the interview. By this Amendment, Applicants have canceled claims 21-27 without prejudice and have added new claims 28-36. The new claims presented herein now recite the method steps of the invention with greater clarity. Support for the new claims can be found in the specification and claims as originally filed. Specifically, support can be found, *inter alia*, at pages 11-13 in the specification. Applicants assert that the present Amendment does not introduce any new matter, and thus, its entry is requested. Upon entry of the present Amendment, therefore, claims 28-36 will be pending and under examination.

**January 27, 2003 Office Action**

**Drawings**

The Examiner indicated that the petition to accept color drawings submitted December 5, 2001 has been granted.

Applicants acknowledge and appreciate the granting of this petition.

Examiner's rejection of claims 21-27 under 35 U.S.C. §112, first paragraph

The Examiner rejected claims 21-27 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. In the Office Action, the Examiner essentially took the position that the Applicants' method is not enabled without providing data showing specific crystal structures.

In response, Applicants maintain that the claimed method is fully enabled by the specification. Applicants' method is directed to identifying new proteasome inhibitors by a novel process of purification that yields proteasomes with sufficient purity to enable crystallization, followed by analysis of the resulting crystals to identify new inhibitors. As thoroughly discussed in the interview, and recorded in the Interview Summary, it is Applicants' position that the Examiner has not made a *prima facie* case as to the necessity of specific crystallographic data. Applicants also believe that new claims 28-35, which recite the method of the present invention with greater clarity, will also serve to address some of the concerns expressed during the interview and in the outstanding Office Action. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §112, first paragraph.

Examiner's rejection of claims 21-27 under 35 U.S.C. §112, second paragraph

The Examiner rejected claims 21-27 under 35 U.S.C. §112, second paragraph as being

indefinite for failing to precisely indicate what biological activity is being tested.

In response, Applicants assert that new claims 28-35, which recite proteolytically active fractions, obviate this rejection. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 21-27 under 35 U.S.C. §112, second paragraph.

Additional issues discussed at the Personal Interview

As discussed during the interview, and reflected in the Interview Summary, the art of record in the case will be reviewed by the Examiner to assess whether the Applicants' claimed method steps reciting the purification of proteasomes is, in the Examiner's opinion, novel and unobvious over this art. The Examiners indicated that if the purification method is in fact novel and unobvious, then it follows that the entire claimed method is novel and unobvious.

In Applicants' view, nothing in the art of record discloses or suggests the Applicants' method as set forth in the claims presented herein. No method in any one reference or any combination of references includes the steps recited in Applicants' claims 28-35. Applicants therefore maintain that the method set forth in the claims presented herein is novel and unobvious over the art of record.

In light of the above remarks, the presentation of new claims 28-35, and the substance of the personal interview conducted June 17, 2003, Applicants believe that the Examiner's rejections set forth in the January 27, 2003 Office Action have been fully overcome and that the present claims fully satisfy the patent statutes. Applicants therefore believe that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned if it is

deemed to expedite allowance of the application.

Respectfully submitted,



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